

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:	§ Group Art Unit: 3623
Rodriguez et al.	§ Confirmation No.: 2337
	§ Examiner: Robinson Boyce, Akiba K.
Serial No.: 09/704,569	§
	§ Attorney Docket No. AUS920000488US1
	§
Filed: November 3, 2000	§
	§ IBM Corporation
Title: System and Method for Automating	§ Intellectual Property Law Dept.
Travel Agent Operations	§ 11400 Burnet Road
	§ Austin, Texas 78758
	§

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July 13, 2006
 Date

APPELLANTS' BRIEF (37 CFR § 41.37)

Mail Stop Appeal Brief-Patents
 Commissioner for Patents
 P.O. Box 1450
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Sir:

A. INTRODUCTORY COMMENTS

This brief is filed in support of the previously filed Notice of Appeal, filed in this case on May 30, 2006, which appealed from the decision of the Examiner dated February 27, 2006, finally rejecting claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41. **Appellants respectfully request that the fee for the previously filed Appeal Brief, filed on June 27, 2005, be applied to this filing, per MPEP § 1204.01, as a final Board decision was never**

rendered in the previous appeal. Therefore, no fee is believed due for the filing of the present Appeal Brief.

No extension of time is believed to be necessary. If, however, an extension of time is required, the extension is requested, and the undersigned hereby authorizes the Commissioner to charge any fees for this extension to IBM Corporation Deposit Account No. 09-0447.

B. REAL PARTY IN INTEREST

The real party in interest in this appeal is International Business Machines Corporation, which is the assignee of the entire right, title, and interest in the above-identified patent application.

C. RELATED APPEALS AND INTERFERENCES

With respect to other prior or pending appeals, interferences, or judicial proceedings that are related to, will directly affect, be directly affected by, or have a bearing on the Board's decision in the pending appeal, there are no such prior or pending appeals, interferences, or judicial proceeding known to Appellants, Appellants' legal representative, or assignee.

D. STATUS OF CLAIMS

1. Total number of claims in application

There are 29 claims pending. Three claims are independent claims (1, 18, and 28), and the remaining claims are dependent claims.

2. Status of all claims in application

- Claims canceled: 2, 11-13, 16, 17, 19, 24, 26, 29, 34, and 36.
- Claims withdrawn from consideration but not canceled: None
- Claims pending: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.
- Claims allowed: None
- Claims rejected: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.

3. *Claims on appeal*

The claims on appeal are: 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41.

E. STATUS OF AMENDMENTS

All amendments have been entered in this case. No amendments have been made to the claims after the Final Office Action.

F. SUMMARY OF CLAIMED SUBJECT MATTER

Appellants provide a concise summary of the claimed subject matter as follows. Claims 1, 18, and 28 are independent claims. Note that claims 1, 3-10, 14, 15, 38, and 41 are method claims, claims 18, 20-23, 25, 27, and 39 are information handling system claims, and claims 28, 30-33, 35, 37, and 40 are computer program product claims. Independent claim 18 includes means plus function limitations that correspond to the method steps set forth in independent claim 1. An information handling system capable of implementing Appellants' invention, as claimed in independent claim 18, is shown in Figures 3, 4, 15, and 21, and described in Appellants' specification on page 21, line 19 through page 24, line 10, page 24, line 11 through page 26, line 2, page 48, line 3 through page 51, line 9, and page 59, line 16 through page 60, line 29. Support for independent computer program product claim 28 is described in Appellants' specification on page 61, lines 1-18. In addition, support for each of the method steps and means plus function limitations of the independent claims are discussed below. The specific citations to Appellants' Figures and Specification are meant to be exemplary in nature, and do not limit the scope of the claims. In particular, the citations below do not limit the scope of equivalents as provided under 35 U.S.C. § 112, sixth paragraph.

The claimed invention is a method, information handling system, and computer program product for handling travel arrangements, including scheduling travel arrangements using a computer system (see e.g., Figure 4, reference numerals 415 and 435; page 24, line 11 through page 26, line 2; also see Figure 7, reference numeral 720; page 30, line 20 through page 31, line 26; also see Figures 15 through 20; page 48, line 2 through page 59, line 15); recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system (see e.g., Figure 15, reference numeral 1515; page 48, line 2 through page 51, line 9); and

sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system (see e.g., Figure 4, reference numerals 460 through 496; page 24, line 11 through page 26, line 2; also see Figure 5, reference numeral 580; page 26, line 2 through 27, line 30; also see Figure 6, reference numerals 670, 675, and 680; page 28, line 1 through page 30, line 19; also see Figure 7, reference numerals 750, 760, and 780; page 30, line 20 through page 31, line 26; also see Figure 8, reference numerals 840 through 890; page 31, line 27 through page 33, line 3).

Appellants argue the claims in several groups, and, as required by 37 C.F.R. §41.37(c)(1)(v), Appellants provide support from the specification for the means plus function elements of each dependent claim argued separately below.

Dependent claim 22 is argued separately below (as part of a group including claims 4-10, 21-23, and 31-33) and includes wherein the service agents include one or more of the telephone systems and wherein the means for sending automated requests include means for configuring a telephone based on the automated requests (see e.g., Figure 4, reference numerals 496 and 498; page 24, line 11 through page 26, line 2; also see Figure 6, reference numerals 610, 615, 670, and 675; page 28, line 1 through page 30, line 19).

Dependent claim 25 is argued separately below (as part of a group including claims 25, 35, and 41) and includes means for receiving the automated request at the electronic calendar system (see e.g., Figure 4, reference numerals 478 and 480; page 24, line 11 through page 26, line 2; also see Figure 7, reference numerals 740, 750, and 760; page 30, line 20 through page 31, line 26), and means for updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements (see e.g., Figure 7 reference numerals 770 and 780; page 30, line 20 through page 31, line 26).

Dependent claim 27 is argued separately below (as part of a group including claims 14, 15, 27, and 37) and includes means for receiving the automated request at a second information handling system (see e.g., Figure 8, reference numeral 840; page 31, line 27 through page 33, line 3); means for searching a database connected to the second information handling system for

requested information (see e.g., Figure 8, reference numeral 840; page 31, line 27 through page 33, line 3); and means for downloading destination related medical information resulting from the searching to a computing device that is accessible by a user (see e.g., Figure 8, reference numeral 870; page 31, line 27 through page 33, line 3).

G. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 3, 18, 20, 28, and 30 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Flake et al., U.S. Patent No. 5,832,451 (hereinafter Flake). Claims 25, 35, and 41 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Gershman et al., U.S. Patent No. 6,401,085 (hereinafter Gershman). Claims 4-10, 21-23, and 31-33 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Levine, U.S. Patent No. 6,076,121 (hereinafter Levine). Claims 14, 15, 27, and 37 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Berman et al., U.S. Patent No. 5,995,939 (hereinafter Berman). Claims 38-40 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Flake in view of Felger, U.S. Patent No. 6,553,108 (hereinafter Felger).

H. ARGUMENTS -

1. Claims 1, 3, 18, 20, 28, and 30 Are Not Anticipated By Flake

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Flake fails to anticipate the presently claimed invention because it fails to show all of the elements of the claimed invention.

Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). Flake is a travel service management information system that uses a database to store data that may be useful when making travel reservations for a customer. For example, a business entity profile and/or individual profile may be used by a travel agent when processing a customer's travel request (see Flake, Abstract).

Appellants teach and claim a method, system, and computer program product for performing various automated tasks based upon a user's travel arrangements, such as cancelling a user's mail delivery and/or changing voice mail messages. Using independent claim 1 as an exemplary claim, Appellants' independent claims include the following elements:

- scheduling the travel arrangements using a computer system;
- recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and
- sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

Appellants respectfully submit that Flake does not teach "sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system," as taught and claimed by Appellants in independent claims 1, 18, and 28. A close reading of Flake does not reveal any *sending* of any type of *automated request* corresponding to scheduled travel arrangements. There is no sending of any type of automated request *from the computer system on which travel arrangements are made to a service agent*. Further, there are no *automated requests based on a user's travel profile*. In short, Flake fails to teach or suggest anything having to do with this element of Appellants' independent claims.

The Examiner cites Flake at col. 2, lines 19-24 and col. 3, lines 42-48 as teaching this aspect of Appellants' claims (see Final Office Action, page 3, lines 4-6). Appellants respectfully disagree. The cited sections of Flake are reproduced below:

In response to a customer's travel request, the system automatically retrieves, and displays for decision-making by an agent, all pertinent information retrieved from the customer's business entity profile and/or individual profile, and the appropriate computer reservation system(s). (Flake, col. 2, lines 19-24).

One or more travel agency customers 16 can communicate with one or more travel agents via any one of a number of communications subsystems 17. Each communications subsystem 17 preferably functions to provide two-way communications between a customer and an agent. For example, one such communications subsystem may be a telephone system, a second such subsystem may be a facsimile machine, and a third such subsystem may be a computer-driven system providing E-mail communications. Travel service request information from a customer is preferably input as data to system 10, by an agent. (Flake, col. 3, lines 42-52).

Note that Appellants claim "scheduling the travel arrangements using a computer system." Appellants further claim "sending one or more automated requests corresponding to the travel arrangements *from the computer system*," i.e. from the computer system that schedules the travel arrangements, "to one or more service agents." The automated requests, i.e. the requests that are sent from the computer system that scheduled the travel arrangements to a service agent, are "based on a traveler's user profile."

The cited portion of Flake discusses a system that maintains information retrieved from various reservation systems. When a customer makes a travel request, the system automatically retrieves and displays pertinent information from the customer's business entity profile and/or individual profile, in order to assist a travel agent with decision-making (Flake, col. 2, lines 19-24). However, it is important to note that the information stored in the business entity and/or individual profiles is used to make the travel arrangements. Flake further states that:

Specifically, under the control of a travel request processing software-assisted routine 82 (described in detail below with respect to Fig. 6), system 10 displays

for the agent (preferably via a workstation 30) the requesting customer's business and/or individual profile information, along with all customer reservation service information the agent may need *to complete the desired travel arrangements*. Subsequently, *after completing the travel arrangements* (typically with the customer's concurrence), the agent inputs appropriate commands via the workstation, and system 10 *stores the travel arrangement information in the relational database* in storage device 24. *The agent then terminates communications with the customer.* (Flake, col. 7, lines 16-28, emphasis added).

Flake clearly uses the customer profile information, both the business entity profile and the individual profile, to assist in making the travel arrangements. After the travel arrangements have been made and stored, the "agent then terminates communications with the customer." However, in contrast to Flake, Appellants are not claiming that *the customer's travel request* is based on the customer profile information. Rather, Appellants claim that "automated requests corresponding to the travel arrangements," i.e. *the travel arrangements that are made by the computer system*, are sent "from the computer system to one or more service agents." It is these automated requests that are "based on a traveler's user profile." Flake does not teach or suggest that "*the automated requests* are based on a traveler's user profile" as taught and claimed by Appellants. Rather, Flake discloses that a customer's travel request may be processed by an agent, or alternately the customer's travel request may be processed automatically, rather than by a travel agent (Flake, col. 5, lines 9-12). In any case, Flake is concerned with a customer's request to schedule travel arrangements. Flake does not teach any automated requests, based on a traveler's user profile, that are sent *from* the computer system that schedules the travel arrangements *to* a service agent, which is what Appellants teach and claim in independent claims 1, 18, and 28.

Further, the individual entity profiles disclosed by Flake pertain to "an individual customer's personal information and travel preferences, such as, for example, the customer's name and address, employer, seating preference, smoking or non-smoking preference, a list of preferred vendors (e.g., airlines), etc." (Flake, col.3, line 65 through col. 4, line 3). Individual entity profiles are used by a travel agent to assist in making travel reservations for a customer

(see Flake, Abstract, lines 7-10). These individual entity profiles are not used as a basis for sending automated requests from the computer system that schedules the travel arrangements to one or more service agents, as taught and claimed by Appellants. Importantly, Flake does not mention of any type of “automated request” being generated, and certainly no “automated request” that is sent *from* the computer system on which the travel arrangements are made *to* “one or more service agents” as taught and claimed by Appellants. Flake merely discloses that when a customer wants to make travel reservations, the travel agent’s computer system automatically retrieves the customer’s user profile in order to assist the travel agent in making the reservations. In contrast, Appellants teach and claim that travel arrangements are scheduled and stored, and then an automated request, corresponding to the travel arrangements, is sent from the computer system on which the travel arrangements were scheduled to one or more service agents.

The Examiner further argues that col. 2, lines 19-24 of Flake teach that “a customer makes a travel request, and in response to the travel request, an automated action is taken, thereby making an automated request inherently implemented by Flake et al.” (see Final Office Action, page 15, lines 11-19). While Flake does disclose that a computer system “automatically retrieves” a business profile or individual profile, this is simply not the same as generating an “automated request,” as taught and claimed by Appellants. The “automated requests” claimed by Appellants are “*based on* a traveler’s user profile,” but they are not identical to the traveler’s user profile. In Flake, the traveler’s user profile is automatically retrieved. However, this is not analogous to *sending an automated request that is based on a user’s profile*, as taught and claimed by Appellants. In other words, Appellants do not simply claim automatically retrieving a traveler’s user profile, which is what it is disclosed by Flake. Rather, Appellants claim sending an automated request that is based on the traveler’s user profile from the computer on which the travel arrangements are made to a service agent.

The cited portion of Flake at col. 3, lines 42-48 (note that lines 42-52 are quoted above) discloses that a customer can communicate with a travel agent using a telephone, a FAX machine, or e-mail. The travel service request information that is sent from the customer to the travel agent, via telephone, FAX, or e-mail, is then “input as data to system 10, by an agent” (Flake, col. 3, lines 50-52). Receiving information from a customer over the telephone (or via

FAX or e-mail) is not the same as sending an automated request corresponding to the travel arrangements from the computer system on which the travel arrangements are scheduled to a telephone system service agent. Flake is simply stating that a customer and a travel agent can talk to each other on the telephone. There is absolutely no teaching of sending any type of automated request to a telephone system, or any other type of service agent.

For the reasons set forth above, Appellants respectfully submit that Flake does not teach “sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler’s user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system,” as taught and claimed by Appellants in independent claims 1, 18, and 28. Therefore, Appellants respectfully submit that independent claims 1, 18, and 28 are not anticipated by Flake. Claim 3 depends from claim 1, claim 20 depends from claim 18, and claim 30 depends from claim 28, and thus are patentable for at least the reasons discussed above. Therefore, Appellants respectfully submit that claims 1, 3, 18, 20, 28, and 30 are not anticipated by Flake, and respectfully request that the rejections to these claims be overturned.

2. Claims 25, 35, and 41 Are Patentable Over Flake In View Of Gershman

Claims 25, 35, and 41 depend from independent claims 18, 28, and 1, respectively, and are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

Using claim 41 as an exemplary claim, claims 25, 35, and 41 add the following elements:

- receiving the automated request at the electronic calendar system; and
- updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.

The Examiner cites Flake at col. 20, line 55 as disclosing that a processor is operable to receive a travel request from a customer (see Final Office Action, page 5, lines 1-3). However, the “automated request” claimed by Appellants is an automated request that 1. corresponds to the travel arrangements, 2. is based on the traveler’s user profile, and 3. is sent from the computer system on which the travel arrangements are made to one or more service agents. As discussed

fully above, Flake does not teach, or even suggest, an automated request as taught and claimed by Appellants in independent claims 1, 18, and 28 (and from which claims 25, 35, and 41 depend).

Gershman purports to teach the use of a wireless device with Internet Protocol capabilities to provide a portable portal into the Internet (see Gershman, Abstract). Appellants respectfully submit that Gershman does not teach or suggest "receiving the automated request at the electronic calendar system," and then "updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements," as taught and claimed by Appellants. The Examiner cites Gershman at col. 10, lines 62-65 and col. 11, lines 15-18 as disclosing these aspects of Appellants' claims (see Final Office Action, page 5, lines 4-12). Column 10, line 62 through column 11, line 21 of Gershman is reproduced below:

In accordance with a preferred embodiment, BackgroundFinder (BF) is implemented as an agent responsible for preparing an individual for an upcoming meeting by helping him/her retrieve relevant information about the meeting from various sources. BF receives input text in character form indicative of the target meeting. The input text is generated in accordance with a preferred embodiment by a calendar program that includes the time of the meeting. As the time of the meeting approaches, the calendar program is queried to obtain the text of the target event and that information is utilized as input to the agent. Then, the agent parses the input meeting text to extract its various components such as title, body, participants, location, time etc. The system also performs pattern matching to identify particular meeting fields in a meeting text. This information is utilized to query various sources of information on the web and obtain relevant stories about the current meeting to send back to the calendaring system. For example, if an individual has a meeting with Netscape and Microsoft to talk about their disputes, and would obtain this initial information from the calendaring system. It will then parse out the text to realize that the companies in the meeting are "Netscape" and "Microsoft" and the topic is "disputes." Then, the system queries the web for relevant information concerning the topic. Thus, in accordance with an objective of the invention, the system updates the calendaring system and eventually the user with the best information it can gather to prepare the user for the target meeting. In accordance with a preferred embodiment, the information is stored in a file that is obtained via selection from a link imbedded in the calendar system.

Gershman appears to disclose an agent, i.e. BackgroundFinder (BF), that helps an individual prepare for a meeting. The BF agent receives input text from a calendar program that indicates the time of the meeting, along with other information, such as the title, body,

participants, location, etc. Using this information, BF queries various sources of information on the web to obtain information about the meeting. This information is stored in a file that can be selected from a link in the calendar system.

Gershman does not appear to have anything to do with receiving an automated request at an electronic calendar system, as taught and claimed by Appellants. Keep in mind that the “automated request” claimed by Appellants is defined in the independent claims as being an automated request “corresponding to the travel arrangements” and “based on a traveler’s user profile.” As further defined by the independent claims, the “automated request” claimed by Appellants is sent “from the computer system” on which the travel arrangements were scheduled. Gershman does not teach, or even suggest, receiving such an automated request at an electronic calendar system, as taught and claimed by Appellants.

Gershman also does not teach or suggest “updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements,” as taught and claimed by Appellants. Although Gershman may update a calendar system with information pertaining to an upcoming meeting, Gershman does not update an electronic calendar with information related to the travel arrangements, as taught and claimed by Appellants. Although the Examiner further cites Gershman at col. 45, lines 48-56 (see Final Office Action, page 5, lines 10-12), Appellants are unclear as to the relevance of this portion of Gershman. The cited section of Gershman appears to be discussing a “daily logistics display” on which a user may “select from various activities based on requirements, including travel 2110, household chores 2120, finances 2130 and marketplace activities 2140” (Gershman, col. 45, lines 50-52). There does not appear to be any discussion of “updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements” as taught and claimed by Appellants. Rather, this section of Gershman simply appears to be pointing out various options on a daily logistics display.

Neither Flake, nor Gershman, nor a combination of the two teaches or suggests Appellants’ invention as claimed. For the reasons set forth above, Appellants respectfully submit that claims 25, 35, and 41 are patentable over Flake in view of Gershman, and respectfully request that the rejections of these claims under 35 U.S.C. § 103 be overturned.

3. Claims 4-10, 21-23, And 31-33 Are Patentable Over Flake In View Of Levine

a. There Is No Motivation To Combine Flake And Levine

MPEP § 706.02(j) states, inter alia:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

MPEP § 2143.01 states, inter alia (emphasis added):

"There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a *prima facie* case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).

"In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification." *In re Linter*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972).

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also *In re Lee*, 277 F.3d 1338, 1342-44, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references); *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

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FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH *PRIMA FACIE* OBVIOUSNESS

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Claims were directed to an apparatus for producing an aerated cementitious composition by drawing air into the cementitious composition by driving the output pump at a capacity greater than the feed rate. The prior art reference taught that the feed means can be run at a variable speed, however the court found that this does not require that the output pump be run at the claimed speed so that air is drawn into the mixing chamber and is entrained in the ingredients during operation. Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

Regarding the references used by the Examiner to support the rejection of claims 4-10, 21-23, and 31-33, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). In general, Levine teaches a system and method to minimize the number of directory numbers (i.e. telephone numbers) that a user requires. Specifically, Levine teaches addressing and translating addresses in a network by adding a functional property code to each device a user employs (see Levine, Abstract). Levine's functional property codes are used to distinguish a device's "type," such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device's functional property code (see Levine, Abstract). Appellants respectfully submit that there is no motivation to combine the teachings of Flake with the teachings of Levine, as this would add unnecessary complexity to Flake's travel service management information system. There does not appear to be any need for a functional property code in Flake as the travel information requests are sent over an existing network, where both the sending and receiving end of the network are configured to communicate with each other, and do not appear to require any specification of "device type" in order to communicate.

The Examiner states that "Flake introduces a subsystem including a packaging/delivery component that is part of the original network in col. 6, lines 38-37" (see Final Office Action, page 16, lines 8-11). The Examiner also cites a portion of Levine (col. 2, lines 7-49) that

discusses a traditional mail delivery system using network terms (see Final Office Action, page 11-15). The Examiner then asserts that “[s]ince both patents introduce delivery in a networked environment, these references are therefore compatible” (see Final Office Action, page 16, lines 15-16). Appellants respectfully disagree. The cited portion of Levine is from Levine’s background section, and is clearly discussing a traditional mail delivery system using roads, delivery trucks, etc. The cited portion of Flake is simply discussing “the manual functions of packaging the tickets and delivering them to customers” (Flake, col. 6, lines 35-37). The cited sections of both Flake and Levine merely mention a traditional mail delivery system, i.e. a *manual* system using roads, delivery trucks, etc. There is absolutely no justification for combining these patents in order to reject Appellants’ claims, which have to do with an *automated* system for handling travel arrangements.

It appears that the Examiner improperly used Appellants’ claims as “guideposts” in selecting the references and simply concluded that it would be “obvious” to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Flake and Levine in order to support a rejection of Appellants’ claims. As stated in MPEP § 2143.03, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the network addressing and translation system of Levine with the travel service management information system of Flake would result in a workable solution without relying on Appellants’ disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants’ claims.

For the reasons set forth above, Appellants respectfully submit that claims 4-10, 21-23, and 31-33 are not obvious, and are therefore patentable over Flake in view of Levine.

b. Flake And Levine Do Not Teach Or Suggest Claims 4-10, 21-23, And 31-33

Claims 4-10, 21-23, and 31-33 each depend, either directly or ultimately, from one of Appellants' independent claims, and are therefore patentable for at least the reasons discussed above with regard to Applicants' independent claims. Claims 4-10, 21-23, and 31-33 add further limitations regarding various types of service agents and automated requests.

Claim 4 adds the elements of "wherein the delivery service agents include one or more parcel services, and wherein the automated requests include one of holding packages for customer pickup, delivering packages on a future date, and leaving packages with a neighbor." Claim 5 adds the elements of "wherein the delivery service agent includes a post office, and wherein the automated requests include at least one of holding mail for customer pickup, delivering mail on a future date, and forwarding mail to another address." Claim 6 adds the elements of "wherein the delivery service agent includes a company mailroom, and wherein the automated requests include at least one of holding mail for future pickup, delivering mail on a future date, and forwarding mail to another address." Claims 21 and 31 add the elements of "wherein the automated requests include at least one of holding packages for future pickup, delivering packages on a future date, and leaving packages at an alternate location."

The Examiner cites Levine at col. 2, lines 8-14, 13-17, and 28 as disclosing these elements of Appellants' claims (see Final Office Action, page 6, line 6 through page 8, line 9). However, the cited sections of Levine are in Levine's background section, and are describing a method of determining which physical path to use, i.e. which roads to use, to deliver a parcel. The cited section of Levine reads as follows (emphasis added):

"A mail or parcel system is a simple network. Each resident has a resident address and each business has a corresponding business address, where an address serves as an origin point (the return address) or destination point (the location the item is addressed to). ***The links are the roads*** and other transportation routes that make the delivery of the mailed items possible. The post offices and parcel handling offices serve as transit point nodes – sorting mail or parcels and directing it to appropriate links for delivery to designated DPs.

...
Provided the DP is legible and meets certain criteria of the network, the office sorts the item according to the link or series of links which optimize the delivery of the item."

The cited section of Levine does not mention anything about automated requests, and certainly does not teach or suggest the various types of automated requests as taught and claimed by Appellants in claims 4-6, 21, and 31. Levine is simply describing a prior art system for determining how best to route parcels *over the road system* from one point to another. Therefore, Appellants respectfully submit that claims 4-6, 21, and 31 are patentable over Flake in view of Levine.

Using claim 7 as an exemplary claim, claims 7, 22, and 32 include the additional limitation of “wherein sending automated requests include configuring instructions corresponding to a telephone.” The Examiner cites Levine at col. 8, lines 45-47 and col. 12, lines 20-35 as disclosing this aspect of Appellants’ invention (see Final Office Action, page 8, line 19 through page 9, line 2). However, as discussed above, Levine is concerned with “transporting an item between points within the network” (Levine, col. 8, lines 30-32). The network may be a telephone network, as disclosed in col. 8, lines 45-47. Levine teaches addressing and translating addresses in a network by adding a functional property (FP) code to each device a user employs (see Levine, Abstract). Levine’s functional property codes are used to distinguish a device’s “type,” such as a telephone or a fax machine, so that more than one device can use the same directory number, and a telephone call can be directed to a particular device using the device’s functional property code (see Levine, Abstract).

The cited section of Levine, i.e. col. 12, lines 20-35, appears to be describing various ways in which a user may enter and modify FP codes. Assigning an FP code to a device is not the same as “sending automated requests” including “*configuring instructions* corresponding to a telephone,” as taught and claimed by Appellants. Levine is not concerned with configuring the telephone itself, but, rather, with assigning a functional property code to the telephone (or other device), so that the FP code can be used at a later point in time to route items between points within the network. As further claimed by Appellants in claims 8-10, 23, and 33, the configuring may include registering the telephone with an e-mail system, changing a voicemail greeting, etc. There is nothing in Levine that discloses this type of configuring. Rather, Levine allows an FP code to be assigned to a telephone or other device. Levine does not teach or suggest “sending automated requests” including “*configuring instructions* corresponding to a telephone,” as

taught and claimed by Appellants. Therefore, Appellants respectfully submit that claims 7-10, 22, 23, 32, and 33 are patentable over Flake in view of Levine.

For the reasons set forth above, Appellants respectfully submit that claims 4-10, 21-23, and 31-33 are patentable over Flake in view of Levine, and respectfully request that they be allowed.

4. Claims 14, 15, 27, And 37 Are Patentable Over Flake In View Of Berman

a. There Is No Motivation To Combine Flake And Berman

Appellants respectfully submit that there is no motivation to combine Berman with Flake. Berman purports to teach that service requests, such as ordering a medical test or requesting authorization for a particular procedure, are prepared and e-mailed to the sponsor system of an appropriate service provider. The request is fulfilled and the results e-mailed back (see Berman, Abstract). Berman further states that “a complete system . . . typically includes hundreds of client systems and dozens of sponsor system” (Berman, col. 2, lines 53-55), and “requires that a database of information, such as the identities of a roster of patients, be built up on the client system” (Berman, col. 3, lines 6-8).

Berman’s automated network service request and fulfillment system is targeted toward the health care industry, such as a doctor’s office for ordering a specific blood test (Berman, col. 4, lines 4-9). In contrast, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). Therefore, Appellants respectfully submit that there is no motivation to combine the teachings of Berman, which has to do with the medical industry, with the teachings of Flake, which has to do with managing travel service information.

The Examiner contends that both Berman and Flake disclose “automated service request/fulfillment systems,” and therefore the references may properly be combined (see Final Office Action, page 17, lines 11-16). Once again, it appears that the Examiner improperly used Appellants’ claims as “guideposts” in selecting the references and simply concluded that it would be “obvious” to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Flake and Berman in order to support a rejection of

Appellants' claims. As stated in MPEP § 2143.03, "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination" (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the automated network service request and fulfillment system of Berman with the travel service management information system of Flake would result in a workable solution without relying on Appellants' disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants' claims.

For the reasons set forth above, Appellants respectfully submit that claims 14, 15, 27, and 37 are not obvious, and are therefore patentable over Flake in view of Berman.

b. Flake And Berman Do Not Teach Or Suggest Claims 14, 15, 27, And 37

Claim 14 depends from independent claim 1, and claim 15 depends from claim 14. Claim 27 depends from independent claim 18, and claim 37 depends from independent claim 28. Therefore, claims 14, 15, 27, and 37 are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

Claim 14 further includes the limitations of "receiving the automated request at the medical information system," and "downloading destination related medical information to a computing device that is accessible by a user in response to the received request." The Examiner cites Berman at col. 3, lines 64-47 and col. 12, lines 24-35 as disclosing these elements of Appellants' claims (see Final Office Action, page 11, line 18 through page 12, line 3). Keep in mind that claim 14 depends from claim 1, which specifically claims sending "automated requests corresponding to the travel arrangements," and further claims that "the automated requests are based on a traveler's user profile." The sections of Berman cited by the Examiner do not have anything to do with travel-related automated requests as taught and claimed by Appellants. Further, the section of Berman cited at col. 12, lines 24-35 is part of Berman's claim 17 that reads as follows:

17. The system of claim 1, wherein each of said service requests is fulfilled by a known one of a plurality of said sponsor systems, said client system further comprising a database of e-mail addresses for said sponsor systems and further programmed to automatically retrieve the e-mail address from said database for the sponsor system which fulfills the service request for which said retrieved service request screen is pre-formatted, and to use said retrieved e-mail address when e-mailing said service request message through said client system's network communication interface and over said computer network to said remote sponsor mailbox.

The Examiner cites Berman's claim 17 as teaching "downloading destination related medical information to a computing device that is accessible by a user in response to the received request." Appellants note that Berman's claim 17, which appears to claim retrieving the e-mail address of a sponsoring system, does not appear to have anything to do with downloading destination related medical information in response to receiving a travel related automated request.

Because Berman does not teach or suggest either of the elements claimed by Appellants in claim 14, Appellants respectfully submit that claim 14, and claim 15, which depends from claim 14, are patentable over Flake in view of Berman.

Regarding claims 27 and 37, the Examiner cites Flake as disclosing "means for receiving the *automated request* at a second information handling system." However, as discussed in detail above, Flake does not teach or suggest an automated request corresponding to travel arrangements, where the automated request is based on a traveler's user profile and is sent from the computer on which travel arrangements were scheduled to one or more service agents. The Examiner further cites Berman as disclosing "means for downloading destination related medical information . . ." As discussed above, Berman does not teach or suggest this element of Appellants' claims. Because neither Flake nor Berman teaches or suggest the elements claimed by Appellants in claims 27 and 37, Appellants respectfully request that claims 27 and 37 be allowed.

For the reasons set forth above, Appellants respectfully submit that claims 14, 15, 27, and 37 are patentable over Flake in view of Berman, and respectfully request that they be allowed.

5. Claims 38-40 Are Patentable Over Flake In View Of Felgera. There Is No Motivation To Combine Flake And Felger

Appellants respectfully submit that there is no motivation to combine Felger with Flake. Felger purports to teach a method for billing a communication session between a user and a value-added service (see Felger, Abstract). The communication sessions discussed in Felger include circuit-switched calls, computer-network telephony calls, and multimedia sessions. In contrast, Flake discloses a method for automatically managing travel service information by storing customer information, business information, and reservation services information in the same database (see Flake, Abstract). Therefore, Appellants respectfully submit that there is no motivation to combine the teachings of Felger, which has to do with billing for communications sessions, with the teachings of Flake, which has to do with managing travel service information.

Once again, the Examiner contends that both references, i.e. Felger and Flake, disclose “automated service request/fulfillment systems,” and therefore the references may properly be combined (see Final Office Action, page 18, lines 3-9), and once again, it appears that the Examiner improperly used Appellants’ claims as “guideposts” in selecting the references and simply concluded that it would be “obvious” to combine the references. In doing so, Appellants assert that the Examiner used impermissible hindsight in combining Flake and Felger in order to support a rejection of Appellants’ claims. As stated in MPEP § 2143.03, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination” (emphasis added). In this case, the prior art simply does not suggest the desirability of combining these references.

Appellants assert that the Examiner fails to satisfy the burden set forth in MPEP §§ 706.02(j) and 2143.03 in support of an obviousness objection, particularly because there is no motivation to combine the references. Furthermore, the Examiner fails to explain how combining the billing system of Felger with the travel service management information system of Flake would result in a workable solution without relying on Appellants’ disclosure. Thus, Appellants contend that the Examiner used impermissible hindsight in rejecting Appellants’ claims.

For the reasons set forth above, Applicants respectfully submit that claims 38-40 are not obvious, and are therefore patentable over Flake in view of Felger.

b. Flake And Felger Do Not Teach Or Suggest Claims 38-40

Claim 38 depends from independent claim 1, claim 39 depends from independent claim 18, and claim 40 depends from independent claim 28. Thus, claims 38-40 are patentable for at least the reasons discussed above with regard to independent claims 1, 18, and 28.

Using claim 38 as an exemplary claim, claims 38-40 add the element of “wherein one of the automated requests results in increasing a user’s electronic wallet balance and decreasing a user’s bank account balance, the user corresponding to the travel arrangements.” The Examiner cites Felger’s Abstract and also Felger at col. 13, lines 61-66 as disclosing this aspect of Appellants’ claims. In claims 38-40, Appellants claim a method, system, and computer program product for “increasing a user’s electronic wallet balance and decreasing a user’s bank account balance” as one of many possible *travel-related automatic requests*. Note that claims 38-40 each depend from an independent claim that specifically claims “automated requests corresponding to the travel arrangements,” and further claims that “the automated requests are based on a traveler’s user profile.” Felger is concerned with billing for communication sessions, and not with automated requests pertaining to travel arrangements, as taught and claimed by Appellants. Felger does not teach or suggest that *a travel-related automatic request* increases a user’s electronic wallet balance and decreases a user’s bank account balance, as taught and claimed by Appellants. Therefore, Appellants respectfully submit that claims 38-40 are patentable over Flake in view of Felger.

Conclusion

For the foregoing reasons, Appellants submit that claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 are patentable over the cited prior art. Accordingly, Appellants respectfully requests that the Examiner's claim rejections be reversed and claims 1, 3-10, 14, 15, 18, 20-23, 25, 27, 28, 30-33, 35, and 37-41 be allowed.

Respectfully submitted,

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I. APPENDIX OF CLAIMS

1. A method of handling travel arrangements, said method comprising:

scheduling the travel arrangements using a computer system;

recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and

sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.
3. The method as described in claim 1 further comprising:

sending includes one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.
4. The method as described in claim 1 wherein the delivery service agents include one or more parcel services, and

wherein the automated requests include one of holding packages for customer pickup, delivering packages on a future date, and leaving packages with a neighbor.
5. The method as described in claim 1 wherein the delivery service agent includes a post office, and

wherein the automated requests include at least one of holding mail for customer pickup, delivering mail on a future date, and forwarding mail to another address.
6. The method as described in claim 1 wherein the delivery service agent includes a company mailroom, and

wherein the automated requests include at least one of holding mail for future pickup, delivering mail on a future date, and forwarding mail to another address.

7. The method as described in claim 1 wherein the service agents include one or more of the telephone systems and wherein the sending automated requests include configuring instructions corresponding to a telephone.
8. The method as described in claim 7 wherein the configuring requests include at least one of changing a voicemail greeting, forwarding calls received at a first phone number to a second phone number, transferring a caller to an alternate phone number, and providing the caller with an emergency contact.
9. The method as described in claim 7 further comprising:
registering the telephone with an email system prior to the configuring, wherein the registering includes sending a message to the email system.
10. The method as described in claim 7 wherein the transferring further includes:
setting a backup contact name, wherein the backup contact name corresponds with an alternate phone number; and
receiving a predefined signal from a calling telephone requesting the transferring to the alternate phone number.
14. The method as described in claim 1 further comprising:
receiving the automated request at the medical information system; and
downloading destination related medical information to a computing device that is accessible by a user in response to the received request.
15. The method as described in claim 14 wherein the medical information corresponds with one or more medical services offered at a travel destination.
18. An information handling system comprising:
one or more processors;
a memory accessible by the processors;
a nonvolatile storage device accessible by the processors; and

a travel automation tool, the travel automation tool including:

means for scheduling travel arrangements using a computer system;

means for recording the scheduled travel arrangements on the nonvolatile storage device; and

means for sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.

20. The information handling system as described in claim 18 wherein the means for sending includes at least one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.
21. The information handling system as described in claim 18 wherein the automated requests include at least one of holding packages for future pickup, delivering packages on a future date, and leaving packages at an alternate location.
22. The information handling system as described in claim 18 wherein the service agents include one or more of the telephone systems and wherein the means for sending automated requests include means for configuring a telephone based on the automated requests.
23. The information handling system as described in claim 22 further comprising:
means for registering the telephone with an email system prior to the configuring, wherein the registering includes means for sending a message to the email system.
25. The information handling system as described in claim 18 further comprising:
means for receiving the automated request at the electronic calendar system; and

means for updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.

27. The information handling system as described in claim 18 further comprising:
- means for receiving the automated request at a second information handling system;
- means for searching a database connected to the second information handling system for requested information;
- means for downloading destination related medical information resulting from the searching to a computing device that is accessible by a user.
28. A computer program product stored in a computer operable media, the computer operable media containing instructions for execution by a computer, which, when executed by the computer, cause the computer to implement a method for handling travel arrangements, said method comprising:
- scheduling the travel arrangements using a computer system;
- recording the scheduled travel arrangements on a nonvolatile storage device connected to the computer system; and
- sending one or more automated requests corresponding to the travel arrangements from the computer system to one or more service agents, wherein the automated requests are based on a traveler's user profile, and wherein at least one of the service agents are selected from the group consisting of a delivery service agent, a telephone system, an electronic calendar system, and a medical information system.
30. The computer program product as described in claim 28 wherein the sending includes at least one of sending an automatic email message, sending an automatic facsimile, and sending an automatic data stream using a predefined protocol.
31. The computer program product as described in claim 28 wherein the automated requests include at least one of holding packages for customer pickup, delivering packages on a future date, and leaving packages at an alternate location.

32. The computer program product as described in claim 28 wherein the service agents include one or more of the telephone systems and wherein the sending automated requests include configuring a telephone based on the automated requests.
33. The computer program product as described in claim 32 wherein the method further comprises:
- registering the telephone with an email system prior to the configuring, wherein the registering includes means for sending a message to the email system.
35. The computer program product as described in claim 28 wherein the method further comprises:
- receiving the automated request at the electronic calendar system; and
- updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.
37. The computer program product as described in claim 28 wherein the method further comprises:
- receiving the automated request at a second computer program product;
- searching a database connected to the second computer program product for requested information;
- downloading destination related medical information resulting from the searching to a computing device that is accessible by a user.
38. The method of claim 1 wherein one of the automated requests results in increasing a user's electronic wallet balance and decreasing a user's bank account balance, the user corresponding to the travel arrangements.
39. The information handling system of claim 18 wherein one of the automated requests results in increasing a user's electronic wallet balance and decreasing a user's bank account balance, the user corresponding to the travel arrangements.

40. The computer program product of claim 28 wherein one of the automated requests results in increasing a user's electronic wallet balance and decreasing a user's bank account balance, the user corresponding to the travel arrangements.
41. The method as described in claim 1 further comprising:
receiving the automated request at the electronic calendar system; and
updating an electronic calendar maintained by the electronic calendar system with information related to the travel arrangements.

J. EVIDENCE APPENDIX

Not applicable.

K. RELATED PROCEEDINGS APPENDIX

Not applicable.